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U.S. Application No. 10/084,484 Examiner CHU, Art Unit 2114
Amendment in Response to First Office Action

REMARKS

In response to the non-final Office Action dated September 14, 2004, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the amended claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") objected to claims 6, 8, 12, and 24 due to antecedence errors. Claims 1-11 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,219,648 to Jones *et al.* Claims 12 and 13 were rejected under 35 U.S.C. § 103 (a) as being obvious over Jones in view of U.S. Patent 6,377,949 to Gilmour. Claims 16-28 were rejected under 35 U.S.C. § 103 (a) as being obvious over Jones. Examiner Chu objected to claims 14 and 15, but Examiner Chu indicated that these claims would be allowable if rewritten in independent form. Examiner Chu also indicated that claims 29-39 are allowed. The Assignee shows that the amended claims are patentably distinguishable over the cited prior art, and the Assignee thus respectfully submits that all the pending claims are ready for allowance.

Allowance of Claims 29-39

Examiner Chu indicates that claims 29-39 are allowed. Examiner Chu is thanked for the allowance.

Objection to Claims 6, 8, 12, and 24

The United States Patent and Trademark Office (the "Office") objected to claims 6, 8, 12, and 24 due to antecedence/dependency errors. These claims have been amended to cure the errors, and Examiner Chu is thanked for the keen eye.

Objection to Claims 14 and 15

Examiner Chu objected to claims 14 and 15. Examiner Chu indicated, however, that these claims would be allowable if rewritten in independent form. The Assignee thus amends

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claim 14 to an independent form, incorporating all the features of base claim 8. Claim 15 remains dependent upon claim 14. Examiner Chu is again thanked.

Rejection of Claims under 35 U.S.C. § 102 (e)

Claims 1-11 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,219,648 to Jones *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, amended, independent claims 1 and 8, and thus the dependent claims thereunder, are patentably distinguishable over Jones. The reference to Jones does not anticipate claims 1-11, so the Assignee respectfully requests that Examiner Chu remove the 35 U.S.C. § 102 (e) rejection and allow claims 1-11.

Independent claims 1 and 8 have been amended. Claim 1, for example, now clarifies features for producing a severity level. As claim 1 recites, a severity level is produced "*for an error referred to in the notification message.*" Claim 1 is reproduced below:

1. (Currently Amended) A method for updating a system monitor message database, the method comprising the steps of:

providing communication between a monitor process software and an output file for receipt by the monitor process software of a notification message held by the output file;

determining if the notification message is a matching notification message or a non-matching notification message by using a rule set; and

producing a severity level for an error referred to in the notification message; and

producing a contact list.

Independent claim 8 includes similar features.

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Jones is completely silent to this severity level. *Jones* fails to make any mention of a "severity level for an error referred to in the notification message." Examiner Chu is correct — *Jones* describes trouble reports having "status," "position," and "age" data fields. These "status," "position," and "age" data fields, however, do not describe a "severity level for an error referred to in the notification message," as claims 1 and 8 recite. These "status," "position," and "age" data fields, instead, describe the age of a customer's trouble report. If the customer's trouble report remains unresolved for a predetermined length of time, *Jones* "escalates" the trouble report to management for resolution. *Jones*, however, only escalates trouble tickets according to age — *Jones* does not "escalate" trouble tickets according to the error, as claims 1 and 8 recite.

Jones fails to describe severity levels. The "status" data field, as *Jones* explains, "indicate[s] the status of the trouble ticket and/or progress of service handling of the same" (U.S. Patent 6,219,648 to *Jones et al.* at column 9, lines 50-53). The "position" data field "identif[ies] ... the technician or service personnel/level assigned to the trouble ticket" (*Jones* at column 9, lines 53-56). The "age" data field "indicates the time duration of the trouble ticket (i.e., the duration of time that the trouble ticket has not been resolved or properly attended to by service personnel)" (*Jones* at column 9, lines 56-60). *Jones*, then, fails to describe severity levels for errors.

Jones does "escalate" old trouble tickets. Examiner Chu is again correct — several times *Jones* describes that older trouble tickets are sent, or "escalated," to higher levels of management (see, e.g., column 11, lines 45-51 cited by Examiner Chu). *Jones*, however, only escalates trouble tickets according to age — *Jones* does not "escalate" trouble tickets according to the error. *Jones* fails to contemplate that notification messages can be categorized according to a "severity level for an error referred to in the notification message," as claims 1 and 8 recite. As *Jones* explains in detail:

Escalation levels may be defined based on the trouble ticket remaining unresolved for a time exceeding user specified time intervals. The escalation levels also control which management level or personnel will receive the alerting message or page

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notification. *Thus, different recipients may be alerted when different time intervals are exceeded.*

(U.S. Patent 6,219,648 to Jones *et al.* at column 9, lines 60-67) (emphasis added). *Jones*, then, fails to understand that notification messages can be categorized according to a “severity level for an error referred to in the notification message,” as claims 1 and 8 recite. *Jones* only “escalates” trouble tickets as the tickets age — *Jones* fails to assign a “severity level for an error referred to in the notification message.” Because *Jones* fails to teach this at least this feature, *Jones* cannot anticipate independent claims 1 and 8. The Assignee, then, respectfully asks Examiner Chu to remove the § 102 rejection and to allow Claims 1-11.

Rejection of Claims 12 & 13 under 35 U.S.C. § 103 (a)

Claims 12 and 13 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Jones* in view of U.S. Patent 6,377,949 to Gilmour. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify “some suggestion or motivation...to modify the reference”; 2) the Examiner must identify “a reasonable expectation of success”; and 3) “the prior art reference must teach or suggest all the claim limitations.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). The Examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. *See id.* at § 2142. “If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” *Id.* Only when the Examiner makes a *prima facie* case does the burden shift to the applicant to present evidence of nonobviousness. *See id.* Because the proposed combination of *Jones* and *Gilmour* fails to describe all the claimed features of independent claim 8, the *prima facie* case of obviousness must fail. The Assignee thus respectfully requests that a Notice of Allowability issue.

1. ***Jones and Gilmour Fails To Describe All Claim Limitations***

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Claims 12 and 13 are not obvious in view of *Jones* and *Gilmour*. Any *prima facie* case of obviousness must teach or suggest all the claim limitations. As the Assignee shows, however, the proposed combination of *Jones* and *Gilmour* fails to teach all the claimed features of claims 12 and 13. Claims 12 and 13 ultimately depend from independent claim 8 and, as discussed above, include the patentable feature “producing a severity level and a contact list using a rule set, the severity level describing an error referred to in the non-matching notification message.” Independent claim 8 is reproduced below:

8. (Currently Amended) A method for managing error notification messages, the method comprising the steps of:

communicating with an output file of a software application to receive a
~~the~~ non-matching notification message;

producing a severity level and a contact list using a rule set, the severity level describing an error referred to in the non-matching notification message;
and

communicating to one or more members of the contact list, the severity level, and the non-matching notification message.

The proposed combination of *Jones* and *Gilmour* is completely silent to at least this feature. **The proposed combination of *Jones* and *Gilmour*, as above explained, only escalates trouble tickets according to age — *Jones* does not “escalate” trouble tickets according to the error. *Jones* and *Gilmour* fails to realize that a notification message can include “a severity level that describes an error referred to in the notification message,” as claim 8 recites. Because the proposed combination of *Jones* and *Gilmour* fails to teach or even suggest this feature, *Jones* and *Gilmour* cannot obviate claims 12 and 13. The *prima facie* case of obviousness must fail, and Examiner Chu is required to remove the rejection.**

2. No Motivation is Present

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Examiner Chu has failed to identify any motivation. Any *prima facie* case of obviousness that combines prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill." Examiner Chu attempts to identify this requirement by quoting a passage from *Gilmour* and by stating that this passage provides the required motivation to support the *prima facie* case of obviousness. The Assignee, respectfully, cannot agree with the Examiner. The Assignee, to the contrary, submits that the quoted passage of *Gilmour* fails to provide any motivation.

Gilmour describes methods and apparatuses for searching electronic documents in a knowledge database. The passage quoted by Examiner Chu merely discusses the problems of organizing and searching an established knowledge management database. That is, even if an organization establishes a knowledge repository, the organization still has a problem making sure the captured information is organized and accessible. As Examiner Chu quotes:

As alluded to above, even once a satisfactory knowledge management information base has been established, the practical utilization thereof to achieve maximum potential benefit may be challenging. Specifically, ensuring that the captured information is readily organized, available, and accessible as appropriate throughout the organization may be problematic.

U.S. Patent 6,377,949 to *Gilmour et al.* at column 2, lines 10-16. This passage provides no motivation to combine *Jones* with *Gilmour*. This quoted passage, instead, describes problems with managing a knowledge database. The "Background of the Invention" section of *Gilmour* describes the problems with establishing a knowledge database. The passage quoted by Examiner Chu merely cautions that problems still remain even after the knowledge database is established. The Assignee cannot accept that the quote passage, discussing these problems, provides the required motivation to support the *prima facie* case of obviousness. The quoted passage, instead, fails to provide the required motivation. The *prima facie* case of obviousness must fail, so Examiner Chu is required to remove the rejection.

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3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success

The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). The Examiner, however, has failed to establish how one of ordinary skill in the art would expect success when combining *Jones* and *Gilmour*. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claims 16-28 under 35 U.S.C. § 103 (a)

Claims 16-28 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Jones*. The patent to *Jones*, however, fails to teach all the claimed features of independent claim 16 and the dependent claims thereunder. Claim 16, like claims 1 and 8, includes the patentable feature "*the severity level describing an error referred to in the non-matching notification message.*" Independent claim 16 is reproduced below:

16. (Currently Amended) A method for updating a system monitor message database, said method comprising:

communicating with an output file of a software application to import a notification message;

comparing the notification message to a message database to determine if the notification message is a non-matching notification message;

communicating the non-matching notification message and a severity level to one or more persons through a graphical user interface, the severity level describing an error referred to in the non-matching notification message; and

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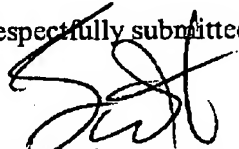
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modifying the severity level by using input from the one or more persons
input into the graphical user interface.

Jones, as repeatedly above explained, only escalates trouble tickets according to age — *Jones* does not “escalate” trouble tickets according to the error. *Jones* fails to realize that a notification message can include “a severity level that describes an error referred to in the notification message,” as claim 16 recites. Because *Jones* fails to teach or even suggest this feature, *Jones* cannot obviate claims 16-28. The *prima facie* case of obviousness must fail, and Examiner Chu is required to remove the rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



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